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ROBERT C KOWERT
MEYERTONS HOOD KIVIN KOWERT & GOETZEL PC
P O BOX 398
AUSTIN, TX 78767-0398

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| EXAMINER |
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ELISCA, PIERRE E

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NOBUYOSHI MORIMOTO

Appeal 2008-0907
Application 09/613,339
Technology Center 3600

Decided: March 26, 2008

Before HUBERT C. LORIN, ANTON W. FETTING, and
DAVID B. WALKER, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

The decision of the Examiner finally rejecting claims 1-44 over prior art is appealed. 35 U.S.C. § 134 (2002). We have jurisdiction under 35 U.S.C. § 6 (b) (2002).

Our review of the record leads us to conclude that this appeal is not in a condition for a decision. Pursuant to 37 C.F.R. § 41.50, we remand and order the Examiner to issue a supplemental Examiner's Answer addressing the issues discussed below.

The Examiner has rejected claims 1, 3-7, 9-31, 32-35 and 37-44 under 35 U.S.C. § 102(e) as being anticipated by Schmid (U.S. Publication 2002/0029188) under 35 U.S.C. § 102(e) and claims 2, 8, 31 and 36 under 35 U.S.C. § 103(a) as being unpatentable over Schmid in view of Andrews (U.S. Patent 6,285,986).

The issue is whether Schmid is available as prior art under 35 U.S.C. § 102(e). Schmid was filed on Dec. 20, 2000. The application on appeal (09/613,339) was filed on Jul. 10, 2000. Schmid is not applicable as prior art under §102(e) unless it is entitled to the benefit of a filing date earlier than Jul. 10, 2000. In that regard, Schmid made a claim of priority to the provisional application No. 60/172,736, filed Dec. 20, 1999. The question then is whether Schmid is entitled to the claim of benefit of the Dec. 20, 1999, filing date of the provisional application under 35 USC 1.119(e) and, if having been accorded that date, Schmid is available as prior art under 35 U.S.C. § 102(e).

The Appellant has argued that the Examiner has not shown that Schmid is entitled to the earlier Dec. 20, 1999 filing date for the subject matter in Schmid that the Examiner relied upon to reject the claims. See App. Br. 17-18. The Examiner responded, for the first time on the matter, by stating: "[T]he Examiner respectfully disagrees with this assertion since the Schmid patent provisional application 60/172,736 discloses the claimed

limitations in pages 1-15. Therefore, Applicant's representative argument is moot." Answer 7. In response, the Appellant argued that this statement was insufficient and repeated the argument that the Examiner has not shown that Schmid is entitled to the earlier Dec. 20, 1999 filing date for the subject matter in Schmid that the Examiner relied upon to reject the claims. Reply Br. 1-4.

We agree with the Appellant that, in the first instance, the Examiner should have established that Schmid is entitled to the earlier Dec. 20, 1999 filing date for the subject matter in Schmid that the Examiner relied upon to reject the claims and thus demonstrated, as part of the prima facie case, that Schmid was properly available as prior art under 35 U.S.C. § 102(e). See *In re Wertheim*, 646 F2d 527 (CCPA 1981).

We remand the application to the Examiner to make the appropriate requisite analysis on the record, showing that the provisional application supports and enables the subject matter in Schmid that the Examiner relied upon in making the rejection in compliance with the first paragraph of 35 USC § 112. If the analysis is made, the Examiner will have shown that Schmid is entitled to the benefit of the filing date of the provisional application under 35 USC § 119(e) and thus established, as a prerequisite to making the prima facie case, that Schmid is available as prior art under 35 USC § 102(e). See MPEP 2136.03:

2136.03 Critical Reference Date [R-6] - 2100 Patentability

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III. PRIORITY FROM PROVISIONAL APPLICATION UNDER
35 U.S.C. 119(e)

The 35 U.S.C. 102(e) critical reference date of a U.S. patent or U.S. application publications and certain international application publications entitled to the benefit of the filing date of a provisional application under 35 U.S.C. 119(e) is the filing date of the provisional application with certain exceptions *if* the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph. . . . [Emphasis original.]

As an additional matter to address upon remand, we direct the Examiner to clarify the status of “LENDINGTREE.COM.” On page 4 of the Answer, within the discussion of anticipation, it states, in its entirety: “Furthermore this process is also readable as [sic] LENDINGTREE.com.” Is LENDINGTREE.com a reference? If it is, the Examiner should explain why this reference anticipates the claimed invention and afford the Appellant an opportunity to respond. If it is not, it should be withdrawn.

This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2006).

REMAND

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Application 09/613,339

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P O BOX 398
AUSTIN TX 78767-0398